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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/531,599

11/09/2005

Philippe Stalder

5019-1004

3680

466

7590

11/24/2008

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EXAMINER

DINH, TUAN T

ART UNIT

PAPER NUMBER

2841

MAIL DATE

DELIVERY MODE

11/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/531,599 | Applicant(s) STALDER ET AL. | |
| | Examiner Tuan T. Dinh | Art Unit 2841 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 16 and 17 is/are pending in the application.
- 4a) Of the above claim(s) 13, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>04/18/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's election with traverse of Group I (claims 1-12) in the reply filed on 07/10/08 is acknowledged. The traversal is on the ground(s) that Groups II and I are co-extensive and no additional burden on search. This is not found persuasive because the inventions have acquired a separate status in the art in view of their different classification; the inventions have acquired a separate status in the art due to their recognized divergent subject matter; the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries); the prior art applicable to one invention would not likely be applicable to another invention.

2. Newly submitted claim 13 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claim 13 recites a tool, which is different from a transponder as claimed in claim 1

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 13, 16-17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

3. Claims 1, 5-6 are objected to because of the following informalities:

Claim 1, line 4 is unclear. The phrase of “said detachable electrical connection” is **lack of antecedence basis**. Please, correct.

Claim 5, lines 1-2 is unclear. The phrase of said intermediate connecting element comprising at least one fastening element that **guarantees its exact positioning**” is not understood because how accuracy that the fastening can be guaranteed, and further, what “**its**” refer to?

Claim 6 is unclear. The phrase of “said electrical connection being...element” is not understood. Since as claimed in claim 1, the electrical connection comprised the intermediate connecting element (circuit board or substrate), so how can the intermediate connecting element can be implement across detachable contact, and the contact being guaranteed by the intermediate connecting element? Please, correct

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Addonisio et al. (U.S. Patent 6,839,035).

As best understood to claims 1-12, Addonisio et al. discloses a transponder comprising an integrated circuit (components or chips 44, 48 mounted on a circuit board 46) and an antenna (42), which is a coil electrically connected to said integrated circuit by electrical connection, characterized in that a electrical connection comprises at least one intermediate connecting element (46) and conductive wire (14) being free, said intermediate connecting element (46), which is a circuit board comprising at least one fastening element (the fastening element which is/are solder to connect the antenna to the circuit board 46 and through holes having pad on the board 46), the circuit board (46) having contacts (pads) for making contact to the antenna.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brown et al. discloses related art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan T. Dinh whose telephone number is 571-272-1929. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Reichard Dean can be reached on 571-272-1984. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tuan T Dinh/
Primary Examiner, Art Unit 2841